

REMARKS

This paper is responsive to the Office Action mailed from the Patent and Trademark Office on March 13, 2007, which has a shortened statutory period set to expire June 13, 2007. A three month extension, extending the period of response until September 13, 2007, is submitted herewith.

Claims 1-40 and 66-76 are pending in the above-identified application and stand rejected for the reasons set forth below. In addition, Claims 24-25 are objected to.

In the current paper, Claims 1, 6, 15, 23, 24, 25, 66, and 73 are amended for clarity. No new matter is entered. In view of these amendments and the following remarks, Applicants respectfully request reconsideration and withdrawal of all pending rejections.

Objections

Claims "24-28" are objected to on page 2 of the Office Action. The stated reasons for the objection appear only in Claims 24 and 25, which are amended herein. Should the Examiner feel the objections persist in Claims 26-28, Applicants request clarification of the objections directed to these claims.

Double Patent Rejections

Claims 6, 10, 15, 19-22 and 73-76 are rejected under the judicially created doctrine of obviousness type double patenting over claims 1 and 6-11 of US Patent No. 6,867,569 (hereinafter "Smith") in view of U.S. Patent No. 5,288,942 (hereinafter "Godfrey").

Applicant respectfully traverses the obviousness-type double patenting rejection as improper. The purpose for rejecting claims under both statutory and non-statutory obviousness-type double patenting is to prevent the unjustified extension of patent exclusivity beyond the term of a patent (MPEP Section 804). In the present case, Claim 1 of Smith is clearly patentably distinguished over Claim 6 of the present application for reasons that have been previously set forth. In particular, Claim 1 of Smith is directed to a "data unit", and, in contrast, pending independent Claim 6 is directed to a "portable card" (Claim 15 is also directed to a "portable card", and Claim 73 is directed to a "magnetically encoded card"). Claim 1 of Smith recites a "data card reader" that is not recited in pending Claims 6, 15 and 73, and Claims 6, 15, and 73 recite an "accessible embedded storage member" that is not recited in Smith. Clearly, the scope of the claimed invention in Smith is entirely different than the scope of the claims in the present application.

Moreover, in response to the Examiner's lengthy new explanation, the fact remains that the subject matter of Godfrey is essentially directed to a wallet, which is entirely different from the present invention and the technology disclosed in Smith, and Applicant does not feel one skilled in the art would have looked to modify a credit card with the keeper technology taught by Godfrey.

For at least the above reasons, Applicant respectfully argues that the present rejection is unsupportable at best, and perhaps may be considered frivolous. Reconsideration and withdrawal is therefore requested.

Rejections Under 35 USC 102

Claims 1, 6, 15, 23, 24, 25, 66 are rejected under 35 USC 102(b) as being anticipated by Tureggelmann (U.S. Patent No. 6,065,681).

Claim 1 is amended herein to recite:

A portable card comprising:  
a substrate with opposing surfaces  
having a predetermined shape, and defining a  
slot-like hollow area extending  
longitudinally between the opposing  
surfaces; and  
an accessible embedded storage  
member disposed inside the hollow area and  
having at least one layer of storage  
material for storing information enclosed by  
said substrate, said storage member  
being movable within the hollow area  
relative to the substrate such that the  
storage member is extractable from the  
hollow area to expose at least a portion of  
said storage member to facilitate processing  
of stored information, and retractable for  
embedment of said storage member within said  
hollow area of said substrate.

Support for recitations of the "opposing surfaces having a predetermined shape", a slot-like hollow area extending longitudinally between the opposing surfaces", "embedded storage member disposed inside the hollow area" and "movable within the hollow area relative to the substrate such that the storage member is extractable from the hollow area to expose at least a portion of said storage member to facilitate processing of stored information, and retractable for embedment of said storage member within said hollow area of said substrate" is provided in Applicant's specification on pages 97-107 (see, e.g., and is shown in Applicant's Figs. 60(A) to 73.

As amended, Claim 1 is distinguished over Tureggelmann because Tureggelmann fails to teach or suggest "a substrate with opposing surfaces having a predetermined shape, and defining a slot-like hollow area extending longitudinally between the opposing surfaces" and "an accessible embedded storage member disposed inside the hollow area and ... movable within the hollow area relative to the substrate such that the storage member is extractable from the hollow area to expose at least a portion of said storage member to facilitate processing of stored information, and retractable for embedment of said storage member within said hollow area of said substrate", as recited in Claim 1. Applicant interprets Tureggelmann as teaching a cavity on the outside of the card, not a "lot-like hollow area extending longitudinally between the opposing surfaces" as recited in Claim 1, and for at least this reason fails to meet the limitations of Claim 1.

Claims 6, 15, 23, 24, 25, 66 are amended in a manner similar to that described above with reference to Claim 1, and are believed to be distinguished over Tureggelmann for reasons similar to those described above. Claim 73, which is not listed in the rejection over Tureggelmann, is also amended to include similar language.

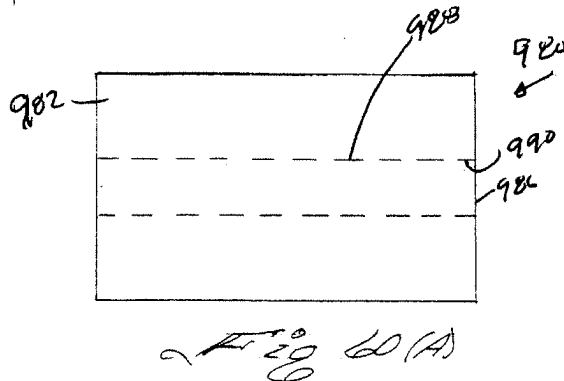
For the above reasons, Applicants' respectfully request reconsideration and withdrawal of the rejections under 35 USC 102.

Rejections Under 35 USC 103

Rejections Over Godfrey (alone)

Claims 1, 2, 6-18, 23-40 and 66-74 are rejected as unpatentable under 35 U.S.C. 103(a) over Godfrey.

The claimed invention is directed to a credit card-type "portable card" including a card-like "substrate" housing a "storage member" for storing information. An exemplary portable card is disclosed in Applicants' Fig. 60(A) (reproduced below for reference with corresponding text from page 97 of Applicants' specification):



The embodiment of a portable card 980 illustrated in Figs. 60(A), 60 (B) and 60 (C) has a substrate 982 formed of a predetermined shape, e.g. rectangular, square, circular or the like. The predetermined shape of the preferred embodiment illustrated in Figs. 60(A), 60 (B) and 60 (C) is that of a credit card. (Page 97, lines 9-14.)

Independent Claim 1 recites that the "portable card" includes a "storage member having at least one layer of storage material for storing information". Claim 1 also recites that the "storage member" is housed in the "substrate" such that the storage member is "movable within

the hollow area relative to the substrate such that the storage member is extractable ... and retractable...".

In contrast to the credit card-type "portable card" recited in independent Claim 1, Godfrey is clearly directed to a credit card holder that includes a "keeper" held between outer covers that form a pocket for receiving a credit card:

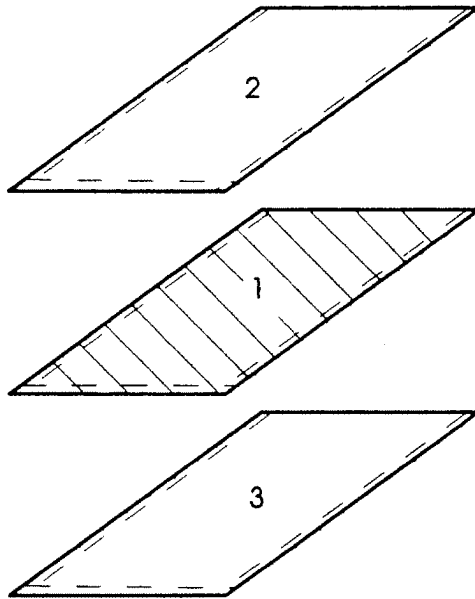


Fig. 2

Godfrey, column 3, lines 4-25

The best mode for carrying out the invention is a cardholder for two credit cards. In FIG. 2, part 1 is the keeper, a first embodiment of said keeper being a composite sheet 0.1 mm thick with a smooth, low friction surface finish. The sheet composition is a fine powder of magnetically soft iron, a polymer such as pvc or polyethylene and a suitable binder, making a material of high resistivity. The soft iron powder content is as high as possible consistent with the requirements of mechanical strength and smooth surface finish of the sheet.

The sheet is homogeneous but an alternative would be a polymer substrate coated on both sides with the ferromagnetic material in a suitable binder. The technology for fabrication of this type of sheet is well known, for example in the manufacture of recording tape and computer floppy discs (which, incidentally, use magnetically hard material).

The outer covers (parts) 2 and 3 are covers made of 0.05 mm thick transparent pvc and may be attached by glueing, welding, stitching or whatever is best suited to the method of manufacture. (Note that known cardholders consist of parts 2 and 3 only).

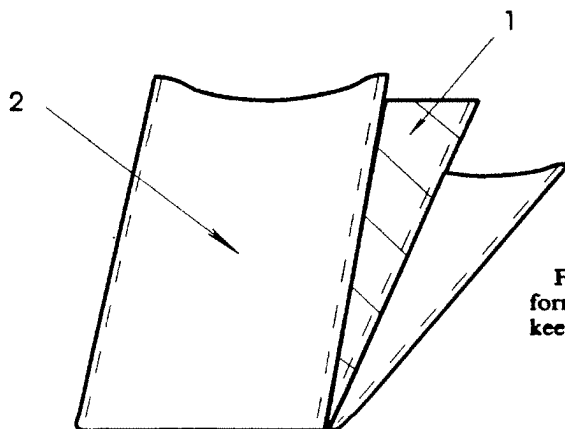


Fig. 3

Godfrey, column 3, lines 55-57

FIG. 3 shows an embodiment of the invention in the form of a cardholder which can be made using one keeper (1) and a folded cover (2).

In rejecting Claim 1 under 35 USC 102 over Godfrey, the Examiner repeats the identical argument previously raised in his rejection under 35 USC 103:

Re claim 1, Godfrey teaches a portable card comprising a substrate having a predetermined shape; and an accessible embedded storage member having at least one layer of storage material (magnetic) for storing information enclosed by the substrate, the storage member and the substrate being adapted to be transported relative to each other to expose at least a portion of the storage member to facilitate processing of stored information and for embedment of the storage member within the substrate (FIG. 3, abstract, and col 1, lines 5+).

Godfrey's Fig. 3 is reproduced above, and Godfrey's abstract and Col 1, lines 5-12 are copied below for reference:

[57]

**ABSTRACT**

In the technical field of known cardholders for devices such as cards with magnetic stripes on which is encoded information and or data in the form of patterns of magnetism, the known cardholders offer no method of 'keeping' (in magnetism terminology) the magnetic patterns. The present invention is characterised by incorporating into the cardholders, keepers in the form of sheets of magnetically soft ferromagnetic material with high resistance. The benefit of the invention is obtained when devices are placed with the reading surface of their magnetized stripes in close contact with the surface of the ferromagnetic material which, making use of known properties of the material, then acts as keeper of the magnetic patterns.

Godfrey, column 1, lines 5-12

**TECHNICAL FIELD**

In the technical field of holders for devices on which information and/or data is encoded in the form of patterns of magnetism, the present invention concerns a method of 'keeping' (in magnetism terminology) the said magnetic patterns. The term 'patterns' includes any arrangement of magnetism such as regular or irregular lines, dots, waves, areas of magnetism, areas of reversed polarity and unmagnetised areas. 5 10

Applicant respectfully traverses the Examiner's characterization of Godfrey as teaching a "portable card", and as including a "storage member...for storing information". As underlined by Applicant's attorney in Godfrey's Abstract and Technical Field above, Godfrey's "keeper" is a clearly a sheet of magnetically soft ferromagnetic material with high resistance whose purpose of is not to store information, but to prevent loss of information from, e.g., credit cards that are stored in the credit card holder (see, for example, column 1, lines 25-35, and column 2, lines 17-24, both reproduced below for reference):

Godfrey, column 1, lines 25-35

Possibly not so well known is the fact that the mag- 25  
netic patterns are subject to gradual degradation due to  
the natural thermal activity and slowing down of the  
magnetic spin of the molecules of the magnetised material. Such degradation can be reduced by the use of  
'keepers' to establish low reluctance paths to enable the 30 20  
magnetic lines of force to complete their natural cir-  
cuits. To achieve this result a keeper should be in close  
contact with the face of the device from which lines of  
magnetism, emanate, i.e. the face from which the en-  
coded information is read. 35

Godfrey, column 2, lines 17-24

The benefit of the invention is obtained when de-  
vices, such as credit cards, are inserted into the card-  
holders with the reading surfaces of their magnetized  
components in close contact with the surfaces of the  
keepers. To avoid physical damage to the magnetized  
components, the keepers having a smooth, low friction  
and/or lubricated surface finish.

Because Godfrey's "keeper" does not store information, Applicants contend that Godfrey's credit card holder is no more a "portable card" than a purse is a credit card. As such, Godfrey fails to anticipate the "portable card" of Claim 1 because Godfrey fails to teach or suggest the "storage member" recited in Claim 1. Further, it would not have been obvious to replace the Godfrey's keeper with a "storage member" because to do so would defeat the entire purpose of Godfrey's stated invention. For at least these reasons, Godfrey fails to anticipate the subject matter of Claim 1, and it would not have been obvious to modify Godfrey to produce the "portable card" recited in Claim 1.

Claim 2 depends from Claim 1, and is therefore distinguished over Godfrey for at least the reasons provided above with reference to Claim 1.

Similar to Claim 1, independent Claims 6, 15, 23, and 66 recite a "portable card" including a "storage member having at least one layer of storage material for storing information" (Claim 73 is slightly different). Each of these independent claims also recites that the "storage member" is housed in the "substrate" such that the storage member is "movable within the hollow area relative to the substrate such that the storage member is extractable ... and retractable...". As such, Claims 6, 15, 23, and 66 are distinguished over Godfrey and any other cited prior art



for reasons similar to those provided above with reference to Claim 1.

Claims 7-14 are dependent from Claim 6, Claims 16-18 are dependent from Claim 15, Claims 24-40 are dependent from Claim 23, Claims 67-72 are dependent from Claim 66, and Claim 74 is dependent from Claim 73. Accordingly, each of these claims is distinguished over Godfrey for at least the reasons provided above with reference to Claim 1.

Rejections Over Godfrey in view of Secondary References

Claims 3 and 25 are rejected as unpatentable under 35 U.S.C. 103(a) over Godfrey in view of U.S. Published Patent Application No. US2001/00052543 (Liu). In response, Claim 3 is dependent from Claim 1, and Claim 25 is dependent from Claim 23. Claims 3 and 25 are therefore distinguished over Godfrey for at least the reasons provided above. Liu is directed to a magnetic cardreader system, and is cited by the Examiner for teaching "circular storage members" (Office Action, page 5). It would not have been obvious to combine the teachings of Godfrey and Liu to produce the "portable card" of Claims 1 and 25 because, as set forth above, Godfrey's keeper is not a "storage member", and replacing Godfrey's keeper with the "circular storage member" taught by Liu would defeat the purpose of Godfrey's invention. Therefore, the rejection of Claims 3 and 25 over Godfrey and Liu is improper and should be withdrawn.

Claims 4-5 are rejected as unpatentable under 35 U.S.C. 103(a) over Godfrey in view of U.S. Patent No. 6,184,788 ("Middlemiss"). In response, Claim 4 and 5 are also dependent from Claim 1, and are therefore distinguished over Godfrey for at least the reasons

provided above. Middlemiss is directed to an electronic missing card alert case, and is cited by the Examiner for teaching "clamshell type cardholder" (Office Action, page 6, second paragraph). It would have been neither possible nor obvious to combine the teachings of Godfrey and Middlemiss to produce the "portable card" of Claim 1 because, as set forth above, neither Godfrey nor Middlemiss are directed to portable cards including "storage members", and modifying Godfrey's holder with the "clamshell type cardholder" taught by Middlemiss would not overcome this deficiency. Therefore, the rejection of Claims 4 and 5 over Godfrey and Middlemiss is improper and should be withdrawn.

Several additional rejections are raised under 35 USC 103(a) over Godfrey in view of another (secondary) prior art reference. Claims 8-9 are rejected as unpatentable under 35 U.S.C. 103(a) over Godfrey in view of U.S. Patent No. 5,237,164 ("Takada"). Claim 10 is rejected as unpatentable under 35 U.S.C. 103(a) over Godfrey in view of U.S. Patent No. 5,858,265 ("Ataie"). Claim 11 is rejected as unpatentable under 35 U.S.C. 103(a) over Godfrey in view of U.S. Patent No. 3,383,252 ("Hynes"). Claim 18 is rejected as unpatentable under 35 U.S.C. 103(a) over Godfrey in view of U.S. Patent No. 4,271,351 ("Bloodworth"). Claims 24 and 26-27 are rejected as unpatentable under 35 U.S.C. 103(a) over Godfrey in view of U.S. Patent No. 5,984,191 ("Chapin"). Claims 29-36 and 72 rejected as unpatentable under 35 U.S.C. 103(a) over Godfrey in view of U.S. Patent No. 5,714,747 ("West"). Claims 37-40 rejected as unpatentable under 35 U.S.C. 103(a) over Godfrey in view of U.S. Patent No. 5,594,233 ("Kenneth"). Claims 37-40 rejected as unpatentable under

35 U.S.C. 103(a) over Godfrey in view of JP410031813 ("Hasabe"). Claims 34-36 and 70-72 rejected as unpatentable under 35 U.S.C. 103(a) over Godfrey in view of U.S. Patent No. 3,595,042 ("Sedley"). Each of these rejections relies on Godfrey, and is therefore traversed for reasons similar to those provided above with respect to the rejections of Claims 3-5 and 25. That is, in each instance it would have been neither possible nor obvious to combine the teachings of Godfrey and the secondary reference to produce the "portable card" of Claim 1 (or any other intervening independent claim) at least because it would not have been obvious to modify Godfrey's holder with the teachings of the secondary reference. Therefore, the rejections of Claims 8-11, 18, 24, 26-27, 29-36, 72, 37-40, 34-36 and 70-72 are improper and should be withdrawn.

For the above reasons, Applicants' respectfully request reconsideration and withdrawal of the rejections under 35 USC 103.

CONCLUSION

For the above reasons, Applicants believe Claims 1-40 and 66-76 are in condition for allowance. Should the Examiner have any questions regarding the present paper, the Examiner is invited to contact the undersigned attorney at the number provided below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Patrick T. Bever", with a stylized flourish at the end.

Customer no. 22888

Patrick T. Bever  
Agent for Applicant  
Reg. No. 33,834  
408-451-5902